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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,396	09/24/2001	Stephen McCann	3036/50289	5628
7590	11/04/2008		EXAMINER	
Crowell & Moring L.L.P. Intellectual Property Group P.O. Box 14300 Washington, DC 20044-4300			WILLIAMS, JEFFERY L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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NOV 03 2008

TECHNOLOGY CENTER 2100

In re Application of: McCann )  
Application No. 09/960,396 )  
Attorney Docket No. 038819.50289 )  
Filed: September 24, 2001 )  
For: Access Authentication System )  
 ) DECISION ON PETITION TO  
 ) WITHDRAW RESTRICTION  
 ) REQUIREMENT UNDER 37 CFR  
 ) §1.144

This is a decision on the petition filed October 30, 2007 under 37 C.F.R. §1.144 and 37 C.F.R. §1.181 to withdraw an outstanding restriction requirement.

The petition is Granted.

RELEVANT PROSECUTION HISTORY

- October 3, 2006      A restriction requirement of subcombinations useable together grouping claims 1-15 and 21 in one group and in the second group claims 16-20 with an election by original presentation of claims 1-15 and 21 was mailed out.
- February 1, 2007      An amendment of the claims and an argument with respect to the restriction was filed by petitioner.
- May 2, 2007      A second restriction requirement was mailed out with claims 1-9 and 21 in group 1 and claims 11-15 and claim 22 in group 2. Again subcombinations useable together was the reason and the arguments were not persuasive.
- August 10, 2007      The restriction requirement was made final.
- October 30, 2007      The petition was filed asking for the restriction to be withdrawn as it is improper and group 1 of claims 1-9 be examined along with claims of group 2 claims 11-15.

November 9, 2007    An amendment was filed changing the scope of claim 11 and cancelling claims 16-20.

### **REGULATIONS AND PRACTICE**

#### **37 C.F.R. § 1.143 states:**

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

#### **37 C.F.R. § 1.144 states:**

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

#### **37 C.F.R. § 1.145 states:**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

#### **37 C.F.R. § 1.181 states:**

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

**CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02....

MPEP § 821.01 states:

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be

repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

### **DECISION**

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner. 37 C.F.R. § 1.144 states that the applicant may petition the Commissioner after a final requirement for the restriction has been made.

In the above-identified application, applicant filed several requests for reconsideration prior to the petition.

The issue presented in the petition is whether the restriction based on original presentation under 37 C.F.R. § 1.145 is proper under the current regulations and practice.

MPEP § 803 sets forth two criteria for a proper restriction requirement between patentably distinct inventions: (A) the inventions must be independent or distinct as claimed and (B) there must be a serious burden on the examiner.

A review of claim 1 indicates that it recites an access authentication system comprising an intended use statement and a wherein clause only and no elements. As there is no burden examining an access authentication system with method claim 1, the restriction is improper.

For the above reasons, the petition is **GRANTED**.

The restriction requirement is hereby **WITHDRAWN**.

The application will be forwarded to the examiner for consideration on the merits of claims 1-9, 11-15 and 21-48.

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/Tod Swann/  
Tod Swann  
Special Programs Examiner  
Technology Center 21400

Application No. 09/960,396  
Decision on Petition

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# **DECISION ON PETITION ROUTING SLIP**

Application No.: 09960396



Art Unit: 2137

**For Director's Secretary:** Granted Denied Dismissed

- Decision to be reviewed and signed by Director
- Mail Decision & enter decision in Petition Database
- Forward a copy of the mailed decision to IFW for scanning
- Enter Paper Nos [ ] and the decision in PALM
- Other [ ]

**For TECH Support Staff:**

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